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Date of Deposit

Maxwell J Petersen

Name of applicant, assignee or  
Registered Representative

Maxwell J Petersen

Signature

March 11, 1994

Date of Signature

**PATENT**

Case No. 1391/1275

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
MICHAEL MCHALE, ET AL. )  
Serial No.: 08/044,240 ) Group Art Unit: 1302  
Filed: April 7, 1993 ) Examiner: C. Sherrer  
For: MULTI-PHASE SHEETED )  
CHEWING GUM AND METHOD )  
AND APPARATUS FOR MAKING )

**RESPONSE TO OFFICE ACTION**

Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Dear Sir:

In response to the second Office Action mailed on March 3, 1994, Applicants provisionally elect the product made by the process of Example 1 as the species, in accordance with the Examiner's helpful suggestion in paragraph 4 of the first Office Action, mailed on December 27, 1993.

The Applicants respectfully traverse the species restriction requirement for the following reasons. First, the species restriction requirement does not comply with M.P.E.P. § 814 which states, in pertinent part:

As pointed out in Ex parte Ljungstrom, 1905 C.D. 541, 119 O.G. 2335, the particular limitations in the claims and the reasons why such limitations are considered to restrict the claims to a particular

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disclosed species should be mentioned if necessary to make the requirement clear. (underline supplied)

In the present case, the Examiner has referred to no specific species claims or claim limitations, or given any reason why any group of species claims might be patentably distinct from each other. Without this information, there appears to be no foundation for the species restriction requirement, and the reasons for the restriction requirement are not clear.

Second, the species restriction requirement does not conform to M.P.E.P. § 808.01(a), which sets forth the procedure for determining if a species restriction is appropriate:

Where there is no disclosure of relationship between species, they are independent inventions. . . There must be a patentable difference between the species as claimed. . . (underlines supplied).

Contrary to M.P.E.P. § 808.01(a), there is an express disclosure of relationship between Applicants' Examples 1, 2 and 3, in the Applicants' specification:

Example 2 is carried out the same as Example 1 except that the high potency sweeteners are removed from the formulation for the first slab (page 20, lines 25-27)

Example 3 is carried out the same as Example 1 except that a candy formulation is used as the second mass (page 21, lines 1-2)

Because neither M.P.E.P. § 814 or § 808.01(a) have been satisfied, Applicants respectfully submit that the

species restriction requirement is manifestly improper, and  
should be withdrawn.

Respectfully submitted,

*Maxwell J. Petersen*

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|---|------------------------------|------------------------|------------------------|
| TRANSMITTAL LETTER  |                              |                        | Case No.<br>1391/1275  |
| Serial No.<br>08/044,240  | Filing Date<br>April 7, 1993 | Examiner<br>C. Sherrer | Group Art Unit<br>1302 |
| Inventor(s)<br>Michael McHale, et al.   |                              |                        |                        |
| Title of Invention<br>MULTI-PHASE SHEETED CHEWING GUM AND METHOD AND APPARATUS FOR MAKING |                              |                        |                        |

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS

Transmitted herewith is a response in the above-identified to the Office Action of March 3, 1994.

- ☐ Small entity status of this application under 37 CFR § 1.27 has been established by verified statement previously submitted.
- ☐ A verified statement to establish small entity status under 37 CFR §§ 1.9 and 1.27 is enclosed.
- ☒ Response to Office Action.
- ☐ No additional fee is required.
- ☐ The fee has been calculated as shown below:

|   | Claims<br>Remaining<br>After<br>Amendment |       | Highest No.<br>Previously<br>Paid For | Present<br>Extra |
|---|---|-------|---------------------------------------|------------------|
| Total                                     |   | Minus |                                       |                  |
| Indep.                                    |   | Minus |                                       |                  |
| First Presentation of Multiple Dep. Claim |   |       |                                       |                  |

| Small Entity       |              | or | Other Than<br>Small Entity |              |
|--------------------|--------------|----|----------------------------|--------------|
| Rate               | Add'l<br>Fee |    | Rate                       | Add'l<br>Fee |
| x \$11 =           | \$           |    | x \$22 =                   | \$           |
| x \$37 =           | \$           |    | x \$74 =                   | \$           |
| +\$115 =           | \$           |    | + \$230 =                  | \$           |
| total<br>add'l fee | \$           |    | total<br>add'l fee         | \$           |

- ☐ Please charge Deposit Account No. 23-1925 (WILLIAM BRINKS HOFER GILSON & LIONE) in the amount of \$ \_\_\_\_\_. A duplicate copy of this sheet is enclosed.
- ☐ A check in the amount of \$ \_\_\_\_\_ to cover the filing fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this communication or credit any overpayment to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.
- ☒ I hereby petition under 37 CFR § 1.136(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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